

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

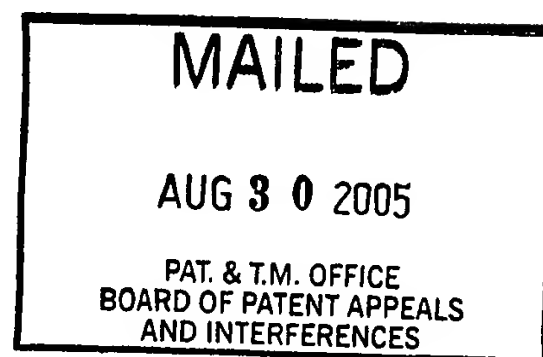
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte OWEN M. PATTERSON

Appeal No. 2005-1389
Application No. 09/977,331

ON BRIEF



Before MCQUADE, NASE, and BAHR, Administrative Patent Judges.
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Owen M. Patterson originally took this appeal from the final rejection of claims 1, 2, 4 through 7, 10 through 19, 21 and 22. The examiner has since withdrawn the rejections of claims 4, 5 and 21 which now stand objected to, along with claims 3, 8, 9 and 20, as depending from rejected base claims. Hence, the appeal as to claims 4, 5 and 21 is hereby dismissed, leaving for review the standing rejections of claims 1, 2, 6, 7, 10 through 19 and 22.

THE INVENTION

The invention relates to “a practice device for improving the putting stroke of a golfer” (specification, page 1). Representative claim 1 reads as follows:

Claim 1. A practice putting device comprising:

- a) a disc;
- b) an annular bottom portion;
- c) an annular central portion;
- d) an annular top portion;
- e) said annular bottom and annular top portion being substantially similar in height;
- f) said central portion having an annular outwardly extending member extending from said bottom and top portions and forming in cross section a substantially truncated conical configuration.

THE REJECTIONS

Claims 1, 2, 6, 7 and 17 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. D444,529 to Wagner.

Claims 10 through 16, 18, 19 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner.

Attention is directed to the main and reply briefs (filed October 20, 2003 and April 9, 2004) and the final rejection and answer (mailed February 20, 2003 and February 10, 2004) for the respective positions of the appellant and examiner regarding the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 102(e) rejection of claims 1, 2, 6, 7 and 17 as being anticipated by Wagner

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Wagner discloses a design for a golf ball capture disc.¹ Figures 1 through 7 respectively show the disc from a right side perspective view, a top plan view, a right

¹ The appellant's characterization of a golf ball capture disc as one of a plurality of adjacent, vertically disposed elements in an assembly for picking up golf balls on a driving range (see pages 8 and 9 in the main brief) is not disputed by the examiner.

side elevation view, a front elevation view, a left side elevation view, a cross sectional view and a left side perspective view.

The appellant contends that Wagner is not anticipatory with respect to claim 1 because it does not meet the limitation in the claim requiring the annular outwardly extending member to form “in cross section a substantially truncated conical configuration.” In this regard, the appellant submits that Wagner’s Figure 6 shows that “[t]he end of the annular outwardly extending member in Wagner is clearly extended, not truncated” (main brief, page 12), and that

[a] truncated conical configuration in cross-section is a cone having its vertex cut off by a plane. Figures 1 and 2 of appellant’s disclosure illustrate the cross-section of annular outwardly extending ring member 18 having a truncated surface 22 that is substantially flat. Also see page 6, lines 17-19 of appellant’s specification. As is apparent, there is no such truncation surface in Wagner [reply brief, page 5].

These arguments are unpersuasive because they are not commensurate with the broad scope of the argued limitation. Claim 1 does not require the substantially truncated conical cross sectional configuration formed by the annular outwardly extending member to be at the end of the member, to be a cone having its vertex cut off by a plane² or to have a truncated surface that is substantially flat such as the surface

² A substantially truncated conical cross-sectional configuration is not a cone having its vertex cut off by a plane. The former is two-dimensional and the latter is three-dimensional.

22 shown in the appellant's drawings. As correctly pointed out by the examiner (see page 5 in the answer and the attachment referred to therein), Wagner's Figure 6 shows an annular outwardly extending member having a cross section which, in the area defined by the pair of inwardly angled flat surfaces, forms a substantially truncated conical configuration to the extent broadly recited in claim 1.

The appellant (see pages 8 through 11 in the main brief and pages 2 through 4 in the reply brief) also urges that claim 1 is not anticipated by Wagner because the reference does not furnish an enabling disclosure for, and thus does not place the public in possession of, the claimed practice putting device. While allowing that it is enabling with respect to the golf ball capture disc shown therein, the appellant submits that the Wagner reference is not enabling with respect to a practice putting device because it fails to teach or suggest placing the capture disc on its side or using a single capture disc by itself without additional capture discs.

Claim 1 recites a practice putting device per se, not a method of using the practice putting device. Because claim 1 is drawn to a putting device per se, the terms "top" and "bottom" which appear in the claim merely serve to differentiate the portions of the device from one another and to set forth an orientation in which the claimed device

is intended to be used. The manner or method in which a device is to be utilized, however, is not germane to the issue of the patentability of the device itself.

In re Casey, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967). It is well settled that the recitation of a new intended use of an old product does not make a claim to that old product patentable. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). The use for which an anticipatory apparatus was intended is irrelevant if it could be employed without change for the purposes of a claimed apparatus. See LaBounty Mfg., Inc. v. United States Int'l Trade Comm'n, 958 F.2d 1066, 1075, 22 USPQ2d 1025, 1032 (Fed. Cir. 1992). The practice putting device recited in claim 1 is structurally identical to the golf ball capture disc disclosed by Wagner notwithstanding that this prior art disc is shown and evidently used in a vertical orientation instead of the horizontal intended use orientation of the claimed putting device. The appellant has not cogently explained, and it is not apparent, why Wagner's golf ball capture disc is not inherently capable of use as a practice putting device as broadly recited in claim 1. Hence, this golf ball capture disc meets, either expressly or under principles of inherency, each and every element of the invention set forth in claim 1. It follows that since Wagner admittedly is enabling with respect to the device disclosed therein, it also is enabling with respect to, and hence places the public in possession of, the device recited in claim 1 which reads on the Wagner device.

Thus, the appellant's position that claim 1 distinguishes over Wagner is not persuasive. Consequently, we shall sustain the standing 35 U.S.C. § 102(e) rejection of claim 1 as being anticipated by Wagner.

We also shall sustain the standing 35 U.S.C. § 102(e) rejections of dependent claims 2, 6 and 7 as being anticipated by Wagner.

Claim 2 further defines the practice putting device recited in parent claim 1 by specifying that "said truncated conical cone has a substantially flat surface." Although the phrase "said truncated conical cone" lacks a proper antecedent basis,³ it clearly refers back, when considered in context, to the substantially truncated conical cross section configuration set forth in claim 1. Wagner's substantially truncated conical cross section configuration has a substantially flat surface as shown in Figure 6.

Claim 6, which depends from claim 1 and recites a bore extending from the top portion through the bottom portion of the claimed practice putting device, falls with its parent claim since the appellant has not challenged the rejection thereof with any

³ This informality, as well as the lack of proper antecedent basis for the term "said widest diameter" in claim 14 and the garbled language in claim 20, should be corrected in the event of further prosecution before the examiner.

reasonable specificity (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

Claim 7 depends from claim 6 and further defines the bore as having top and bottom shoulders. As shown in Figure 6, the Wagner device contains a bore having “top” and “bottom” shoulders at its ends.

We shall not sustain the standing 35 U.S.C. § 102(e) rejection of claim 17.

Claim 17 depends from claim 1 and requires the top and bottom portions of the claimed practice putting device to be mirror images of one another. Wagner's drawings clearly show that the “top” and “bottom” portions of the prior art golf ball capture device are not mirror images of one another.

II. The 35 U.S.C. § 103(a) rejection of claims 10 through 16, 18, 19 and 22 as being unpatentable over Wagner

Dependent claims 10 through 16, 18, 19 and 22 further define the practice putting device recited in parent claim 1 as having specific parameters which are described in the underlying specification as being particularly pertinent to the disclosed use of the claimed device to practice putting. Implicitly conceding that the Wagner golf

ball capture disc does not embody these parameters, the examiner submits that “the exact weight and dimensions of Wagner’s device would obviously have been dependent on the durability desired and the number of golf balls one wished to be able to collect in a single pass” (final rejection, page 2). Be that as it may, such conclusion has no apparent relevance to the practice putting disc parameters set forth in the subject claims.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 10 through 16, 18, 19 and 22 as being unpatentable over Wagner.

SUMMARY

The appeal as to claims 4, 5 and 21 is dismissed, and the decision of the examiner to reject claims 1, 2, 6, 7, 10 through 19 and 22 is affirmed with respect to claims 1, 2, 6 and 7 and reversed with respect to claims 10 through 19 and 22.

DISMISSED-IN-PART, AFFIRMED-IN-PART AND REVERSED-IN-PART

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